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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,688	07/12/2001	Hideo Ogiwara	P 282642 T7KK-01S0230	1610

909 7590 12/02/2003

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EXAMINER

RICKMAN, HOLLY C

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,688

Applicant(s)

OGIWARA ET AL.

Examiner

Holly Rickman

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6 and 19 is/are rejected.
- 7) ☒ Claim(s) 14, 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/15/03 has been entered.

Claim Objections

2. The objection to claims 5 and 11 (because of the following informalities: the phrase "exhibits a soft magnetic properties" in line 3 of each claim is grammatically incorrect) is withdrawn in view of Applicant's amendments.

3. Claims 14 and 18 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 1 and 7, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. The rejections of claims 2-5 and 8-12 under 35 U.S.C. 112, second paragraph, are withdrawn in view of Applicant's amendments

6. Claims 6 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "fine particles" in claim 19 is a relative term which renders the claims indefinite. The term "fine particles" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 6 is rendered indefinite by the limitation "the magnetization of said layer...is not saturated under the temperature around room temperature and under the applied magnetic field not higher than 796,000 A/m, and the layer...has a saturation magnetization under the temperature not higher than 10K and under the applied magnetic field not higher than 3980 A/m." Thus, the magnetization of the layer is saturated below 10K and 3980 A/m and is not saturated below room temperature and 796,000 A/m. This limitation is indefinite because ranges overlap and thus, it is not clear how the layer can be saturated and unsaturated at the same time (i.e., 0-3980 A/m falls within the range of less than 796,000 A/m and 0-10K falls within the range of less than room temperature).

Claim Rejections - 35 USC § 102

7. The rejection of claims 1-3, 13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirotaka et al. (JP 11-149628) is withdrawn in view of Applicant's amendments.

Claim Rejections - 35 USC § 103

8. The rejection of claims 7-9, 17, and 20 under 35 U.S.C. 103(a) as being unpatentable over Hirotaka et al. (JP 11-149628) in view of Onda (US 6417991) is withdrawn in view of Applicant's amendments.

9. The rejection of claims 15 and 19 under 35 U.S.C. 103(a) as being unpatentable over Hirotaka et al. (JP 11-149628) is withdrawn in view of Applicant's amendments.

Allowable Subject Matter

10. Claims 6 and 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 6 and 19 are allowable over the closest prior art to Hirotaka et al. which fails to disclose a structure having the claimed properties (i.e., magnetization less than or equal to 20 emu/cm² when a magnetic field of 796000 A/m is applied at 300 K). Furthermore, there is no basis to believe that the claimed properties would be inherently present in the structure taught by Hirotaka et al.

Art Unit: 1773

11. Claims 1-13, 15-17, 19-20 are allowable over the closest prior art to Hirotaka et al. for the reasons set forth above.

Response to Arguments

12. Applicant's arguments filed 9/15/03 have been fully considered but they are not persuasive because it is still unclear, how claim 6, rejected above under 35 USC 112, 2nd paragraph, is, in fact, definite. Thus, this rejection has been maintained.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Rickman whose telephone number is (703) 305-2642. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Holly Rickman
Primary Examiner
Art Unit 1773

hcr
November 26, 2003